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09/898,958	07/03/2001	Jack V. Smith		9735

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P.O. Box 156  
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EXAMINER

LUONG, SHIAN TINH NHAN

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/898,958

**Applicant(s)**

SMITH, JACK V.

**Examiner**

Shian T. Luong

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Response to Amendment***

1. The amendment filed on 10/28/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the box does not contain any independent parts which are placed in the box after or before inflation of the cushion.

Applicant is required to cancel the new matter in the reply to this Office Action.

2. Claim 5 is not an original claim but a new claim. Applicant should change the status indicator to reflect the actual status of the claim.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not specify a box without any independent part which are placed in the box after or before inflation of the cushion.

5. Claims 1,3,5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

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the invention. Claim 1 appears to be indefinite and inaccurate. The disclosure requires the box to be closed prior to inflation and yet the claim requires inflation prior to be sealed. The claim appears to be in contradiction of the specification. In claim 5, it is not clear as to the structure of any independent part. Clarification is required.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1,3,5 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Sperry et al. (US 6,253,919) in view of Hollingsworth et al (US 6,334,534). Sperry et al. discloses a box 66,566 comprised of rigid material. The box is a typical box with top and bottom closing flaps 107,108. The term rigid material is a relative term and the box is considered relatively rigid with respect to another article such as a sheet of paper. An inflatable cushion 10,450,510 is situated within the box and covers the inside walls and the bottom of the box as shown in Figures 3,11,12b. A valve 16,451,516 connects the outside of the box through a hollow lumen to the inside of the cushion allowing air to pass through from the outside of the box to the inside of the cushion allowing inflation of the cushion. The hollow lumen is the portion on the top half of element 16. The filling medium is air. In operation, the inflatable cushion is placed into the box. The operator then places the articles on top of the cushion (column 7, lines 46-48). The container top flaps are closed and sealed and the cushion is inflated

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(column 7, lines 48-49 and lines 59-61). There is no other article placed in the box after or before inflation of the cushion.

Sperry et al. disclose generally all of the elements of claims, but does not show the attachment means. However, Hollingsworth et al. suggests, for example, a cushion with fastener elements 52 to attach the cushion to the interior surface of a case. It would therefore have been an obvious modification in view of Hollingsworth to provide the fastener members for the inflatable packing material to attach the packing material to an interior surface of the container to prevent unwanted movement.

### ***Response to Arguments***

3. Applicant's arguments filed on 10/28/04 have been fully considered but they are not persuasive. Applicant argues on page 3 that the invention does not contain any external devices to function properly unlike Sperry. But Sperry also does not contain any external devices necessary for the functioning of the inflatable device once it has been inflated. The dunnage serves the same function as an inflatable cushion. In fact, the dunnage was equated to an inflatable packing material in column 1, lines 4-5. Also, contrary to applicant's assertion on page 3, this is the device and the main invention of Sperry.

With respect to applicant's argument on page 4, line 4 and lines 7-11, the examiner never applied the dunnage as the container, but has been relying on the dunnage bag only as a cushioning device. The outer container or box is shown by element 66 or 566. The dunnage is placed within the box and the label is on the outer surface of the box. It is never Sperry's intention to ship the dunnage without the box.

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Applicant also argued that the Sperry reference describes a method for using a dunnage bag that is placed inside of a container and the present invention has no such limitation. Applicant also argued that this invention does not require the multiple steps and requirement of Sperry. But the claim does not limit extra structural elements within the valve assembly nor the entire invention of Sperry. In addition, applicant attempts to obviate the rejection by arguing the method steps in a product claim. But it is well settled that the patentability of a product ordinarily can not depend on its method of being made. See In re Thorpe, 777 F.2d 695, 227 USPQ 964 (1985). Also note MPEP 706.03(e), In re Brown, 59 CCPA 1063, 173 USPQ 685 (CCPA 1972); In re Fessmann, 180 USPQ 324 (CCPA 1974) regarding the Office's lesser burden of proof in product-by-process claims.

Applicant argued that Hollingworth has no relevance in this case. Sperry teaches an inflatable packaging material used to fill void regions in containers carrying articles for shipment. It contains an outer box 64 with bottom closing flaps made out of rigid material with an inflatable cushions 10,450,510 situated within the box. Notice that cushion 450 covers inside walls by portions 454,452 and cover a bottom wall by portion 456. A valve assembly 16,451,516 is mounted in an opening in the wall of the box. The opening is flush with an outer surface 75 of wall 64. After the top flaps are closed, the inflatable packaging material is inflated through the valve 16 with an inflating system. It is evident that the structural features in Sperry et al. correspond to what is being claimed except for the attachment. Hollingsworth is an appropriate motivational reference for the attachment because it is a cushion for use in a carrying case. The attachments allow the user to adjust the location of the cushion and to stabilize the cushion around the article. Also with regard to Hollingsworth, the examiner is only relying the

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simple hooks and loops attachment to the interior of a carrier and not its additional structural feature.

Applicant's consistent argument that Sperry's dunnage bag is not a inflatable cushion. But the definition for a dunnage is a packing material used to protect a ship's cargo from damage during transport. The material itself is a cushion for the cargo or any article packed therein. Hence, dunnage is a term that corresponds to applicant's cushion.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant's argument on page 8-9 is inaccurate because Sperry's cushion 450 covers inside walls by portions 454,452 and cover a bottom wall by portion 456. To argue that it does not cover more than one side of the article does not correspond to what is shown in Figure 11.

Applicant also argued on page 10 that the combined references do not overcome the unexpected result of the instant invention. Applicant has not shown any unexpected result from the disclosure and has not presented any evidence to show any unexpected result. Also, applicant argued on page 11 that the Sperry bag is not used for shipping or storage of items for shipping. But column 1 of Sperry specifically discloses the use of dunnage bag to cushion articles for shipment. Hence, applicant's assertion is inaccurate.

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Applicant's other arguments have been considered but they are also found unpersuasive to overcome the instant rejection.

Applicant has requested constructive assistance to place the case in condition for allowance. However, the examiner has reviewed the application and regrettably cannot arrive with any claim limitation to overcome the prior art at this time. Therefore, the examiner cannot assist applicant with claim construction as requested.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical



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section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners, M.P.E.P. 203.08. The **Group clerical receptionist number is (703) 308-1148.**

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Donna Monroe at (703) 308-2209.

For applicant's convenience, the formal FAX number is (703) 872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify Examiner Luong of Art Unit 3728 at the top of your cover sheet of any correspondence submitted.

Inquiries concerning the merits of the examination should be directed to Shian Luong whose telephone number is (571) 272-4557. The examiner can normally be reached on M-H from 7:00am to 4:00pm EST.

STL

December 22, 2004

Primary Examiner

  
Shian Luong

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